

EXPRESS MAIL NO. EV486546397US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Stern et al.

Applicants: Randolph A. Stern and Michael N. Byles
Serial No.: 09/558,329
Appeal No.: 2005-0019
Confirmation No.: 9722
Filed: April 25, 2000
Examiner: Cheryl Juska
Group Art Unit: 1771
Title: Stitch Bonded Fabric and Fluid-Retaining Fabric Made Therewith

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Cincinnati, OH 45202

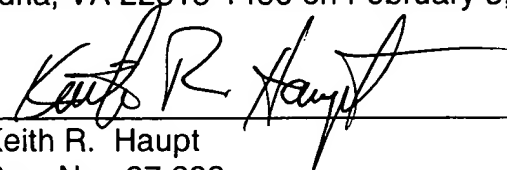
February 3, 2005

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
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Sir:

REQUEST FOR REHEARING UNDER 37 CFR 1.197(b)

I hereby certify that this correspondence is being deposited in triplicate with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated below and is addressed in an envelope addressed to: Board of Patent Appeals and Interferences, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on February 3, 2005.


Keith R. Haupt
Reg. No. 37,638

Feb. 3, 2005
Date

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REQUEST FOR REHEARING UNDER 37 CFR 1.197(b)

This Request for Rehearing under 37 C.F.R. § 1.197(b) is in response to the Board's Decision on Appeal dated January 19, 2005 in the above-captioned appeal.

The Decision on Appeal addresses two classes of rejections: an enablement rejection with respect to claims 30-87 under 35 U.S.C. § 112, first paragraph; and prior art rejections under 35 U.S.C. §§ 102 and 103 with respect to claims 1-87, all of the claims presented for appeal and pending in this application. The Board reversed the § 112 rejection, but affirmed the prior art rejections.

Regarding the prior art rejections, the Board correctly noted that Appellant's have consistently made one argument relative to each of the prior art

rejections; namely, that the Examiner failed to properly interpret the phrase "yarn face" as having very closely spaced or densely packed yarn segments such that the underlying felt is not generally exposed (i.e., the yarn face defined an "effectively continuous" surface). The Board concluded that the term "yarn face" was not defined so specifically, and so reviewed the claims on the basis that the term did not require an effectively continuous surface. The key distinction Appellants had asserted over the prior art was in the difference between an effectively continuous surface versus the spaced apart yarns at the surface in the prior art. As the Board's interpretation no longer included that key distinction, the rejections under §§ 102 and 103 were affirmed.

Appellants hereby request rehearing under 37 C.F.R. § 1.197(b) and request that the Board further elaborate on the prior art rejections as to whether Appellants' more narrow interpretation of the term "yarn face" is anticipated by or obvious in view of the identified prior art.

Specifically, pursuant to a relatively recently enacted regulation, the opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection.¹ Specifically, Appellants hereby solicit from the Board a new decision (or an amended decision) with an express statement as

¹ 37 C.F.R. § 41.50, effective September 13, 2004 in pertinent part, reads as follows:

"(c) The opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection. When the opinion of the Board includes such a statement, Appellant has the right to amend in conformity therewith. An amendment in conformity with such a statement will overcome the specific rejection. An examiner may reject a claim so-amended, provided that the rejection constitutes a new ground of rejection."

to whether a claim amendment reciting “effectively continuous yarn face” would overcome the specific prior art rejections.

Appellants respectfully assert that such a statement by the Board is ripe for consideration in that throughout the litany of Amendments, Responses to Office Actions, Appeal Briefs, Reply Briefs and Supplemental Briefs Appellants steadfastly asserted such an interpretation of the term “yarn face.” Moreover, Appellants respectfully assert that the term “yarn face” has been expressly asserted in the prosecution history of the present application and any broader definition of that term has been disclaimed by Appellants. Appellants respectfully request that the Board consider this particular point which may have been overlooked in rendering the decision of January 19, 2005 in light of the relatively new enactment of 37 C.F.R. § 41.50(c).

Additionally, such a statement by the Board would conserve both the resources of the USPTO and provide Appellants a clear indication whether continued prosecution of this application with such an amendment is worthwhile. Alternatively, Appellants will consider filing a request for continued examination in which each of the rejected independent claims are explicitly amended to include the more narrow definition of the term “yarn face.” Such additional expense by Appellants and review by the USPTO would be warranted in light of a favorable indication by the Board.

Appellants respectfully assert that this issue was repeatedly presented both to the Examiner in a personal interview conducted on December 21, 2000 in which the Examiner noted in the Interview Summary Record that “With regard to the prior art rejections, Haupt (Appellants’ attorney) noted col. 2, lns. 48-65 of the present disclosure, wherein the top and bottom yarn faces are described. Haupt argued said faces are a distinguishing feature over the cited prior art. I agreed to review the prior art

with this feature in mind. Upon my agreement of said distinguishing feature, we agreed to amend all independent claims, if needed, to reflect said feature.”


Likewise, this issue which was presented by Appellants, for example in the Reply Brief of May 14, 2004 on pgs. 5-7; the Examiner’s Answer of March 12, 2004 on pg. 26; Appellants’ Supplemental Appeal Brief of October 2, 2003 pgs. 15-16; Appellants’ Reply Brief of March 29, 2002 pg. 7; and Appellants’ Brief on Appeal of November 26, 2001 on pgs. 2 and 14-15.

Conclusion

For the reasons stated herein and previously, Appellants respectfully urge the Board to provide a revised Decision on Appeal pursuant to 37 C.F.R. § 41.50(c) addressing a claim amendment to the term “yarn face” to overcome the current prior art rejections.

Respectfully submitted,

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